

REMARKS

Claims 1-24 remain pending, with claims 1-4 and 17-24 withdrawn from consideration. Applicants respectfully request reconsideration of this application in view of the following remarks.

I. Regarding the final Office Action

In the Office Action,¹ the Examiner rejected claims 5, 6, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,629,136 to Naidoo ("*Naidoo*") in view of U.S. Patent No. 6,058,311 to Tsukagoshi ("*Tsukagoshi*"), and further in view of U.S. Patent No. 6,311,185 to Markowitz et al. ("*Markowitz*"); rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and U.S. Patent No. 6,072,875 to Tsudik ("*Tsudik*"); and rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and U.S. Patent No. 6,636,489 to Fingerhut ("*Fingerhut*").

Applicants gratefully acknowledge the Examiner's withdrawal of all previous rejections (Office Action at p. 9). Applicants respectfully traverse the Examiner's rejections for the following reasons.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action

II. Regarding the rejection of claims 5, 6, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5, 6, 9-11, and 14-16 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Tsukagoshi* nor *Markowitz*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Independent claim 5 recites a combination including, for example,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier.

The Examiner concedes that neither *Naidoo* nor *Tsukagoshi*, taken alone or in combination, teaches or suggests at least these elements (Office Action at pp. 3, 4).

Nevertheless, the Examiner alleges,

Markowitz teaches a system where there are multiple profiles of a user which stores different information and certain user profile can be sent to a server provider (col. 3, lines 1-49)

(emphasis added, Office Action at p. 4). The cited portion of *Markowitz* recites “[i]nformation such as the user’s age, sex and hobbies ... [and] attitudes, opinions, and interests” (*Markowitz*, col. 3, lines 11-18). *Markowitz* teaches “a Web page modifier ... inserts the selected advertisement based on the attributes of the requested Web page” (*Markowitz*, col. 4, lines 1-4). However, neither the cited portion of *Markowitz*, nor any other portion, teaches or suggests at least,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier

(emphasis added) as recited by independent claim 5. By sending the “service request information to said service provider ... without the temporary identifier,” as recited by claim 5, it is impossible for the service to know the user’s private identity from the service request information.

Because neither *Naidoo*, *Tsukagoshi*, nor *Markowitz*, taken alone or in combination, teaches or suggests each and every element recited by independent claim 5 and required by dependent claims 6 and 9-11, no *prima facie* case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 5, 6, and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz*.

Independent claim 14, although of different scope, recites elements similar to elements discussed above with respect to claim 5. Claims 15 and 16 depend from claim 14 and therefore include all of the elements recited therein. Accordingly, for at

least the reasons discussed above with respect to claim 5, no *prima facie* case of obviousness has been established for claims 14-16. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claims 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz*.

Moreover, Applicants respectfully remind the Examiner that M.P.E.P. § 2143.03 instructs,

[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)

(emphasis added). Applicants also respectfully remind the Examiner that M.P.E.P. § 706.02(j) instructs,

[I]t is important for an examiner to properly communicate the basis for a rejection so that the issue can be identified early and the applicant can be given a fair opportunity to reply.

The Examiner's rejections are not properly communicated, at least because the Examiner has not indicated how *Markowitz* allegedly teaches or suggests each and every element recited by independent claim 5. Because the Examiner's rejections are not properly communicated, Applicants respectfully request the Examiner to withdraw the finality of the Office Action mailed June 29, 2005.

III. Regarding the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Tsudik*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 7 and 8 because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not

been established because, among other things, neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Tsudik*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

As noted above, independent claim 5 recites a combination including, for example,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier.

(emphasis added). Also as noted above, neither *Naidoo*, *Tsukagoshi*, or *Markowitz*, taken alone or in combination, teaches or suggests at least these elements recited by independent claim 5 and required by dependent claims 7 and 8.

Tsudik fails to cure the deficiencies of *Naidoo*, *Tsukagoshi*, and *Markowitz*. The Examiner asserts "Tsudik teaches two different identifier[s] being corresponded to each other(Abstract)" (Office Action at p. 7). Even assuming this assertion is true, *Tsudik* fails to teach or suggest at least,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier,

as recited by independent claim 5 and required by dependent claims 7 and 8.

Because neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Tsudik*, taken alone or in combination, teaches or suggests each and every element required by dependent claims 7 and 8, no *prima facie* case of obviousness has been established with respect

to these claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Tsudik*.

IV. Regarding the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Fingerhut*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 12 and 13 because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not been established because, among other things, neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Fingerhut*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

As noted above, independent claim 5 recites a combination including, for example,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier

(emphasis added). Also as noted above, neither *Naidoo*, *Tsukagoshi*, nor *Markowitz*, taken alone or in combination, teaches or suggests at least these elements recited by independent claim 5 and required by dependent claims 12 and 13.

Fingerhut fails to cure the deficiencies of *Naidoo*, *Tsukagoshi*, and *Markowitz*. The Examiner asserts "Fingerhut teaches a location independent service provider"

(Office Action at p. 8). Even assuming this assertion is true, *Fingerhut* fails to teach or suggest at least,

wherein said communication control unit ... stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier,

(emphasis added) as recited by independent claim 5 and required by dependent claims 12 and 13.

Because neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Fingerhut*, taken alone or in combination, teaches or suggests each and every element required by dependent claims 12 and 13, no *prima facie* case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Fingerhut*.

V. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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